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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,628	08/28/2003	Yoshio Osada	Q76843	5545
23373	7590	08/05/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			ASHLEY, BOYER DOLINGER	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/649,628	<b>Applicant(s)</b> OSADA, YOSHIO	
	<b>Examiner</b> Boyer D. Ashley	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/817,189.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/28/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

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## **DETAILED ACTION**

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No.09/817189, filed on 3/27/01, and parent application No. 09/468,127, filed on 12/21/99. It should be noted that the earliest effective filing date of the instant application is at most 9/8/00 because application number 09/468,127 and foreign document HEI 11-67109 do not include the claimed subject of the instant application.

### ***Specification***

2. The disclosure is objected to because of the following informalities: on page 13, the reference to the U.S. Patent 6,495,932, is incorrect. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "... the plunger extending in its axial direction" is confusing, in that, it is not clear what the "its" language is referring to. Does the plunger extend in the axial direction of the housing? If not, then the phrase is confusing, in that, the plunger if extending must be extending in an axial direction". Better language would be "... the plunger extending in an axial direction".

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As to claim 14, there is no positive antecedent basis for "the elongated hole" and "the roller shaft". Shouldn't this claim be dependent upon claim 13?

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 6-7, and 15 are rejected under 35 U.S.C. 102(e) as anticipated by Neitzell, U.S. Patent 6,508,151.

Neitzell discloses the same invention as claimed including: a housing (20) for accommodating a motor (not shown, see column 3, lines 12-15); a driven shaft (42) rotatably supported by the housing and rotated by the motor; a plunger (24) capable of reciprocative motion with respect to the housing and having a front end (28) to which a saw blade (30) is attached, the plunger extending in an axial direction (see Figure 2); a first motion (48) converting mechanism interposed between the driven shaft and the plunger; a counterweight (26) causing reciprocative motion with respect to the housing (see column 3, lines 1-15); a second motion converting mechanism (52) interposed between the shaft and the counterweight; a guide sleeve (56) extending in the axial direction the plunger (see Figures 1-2, 5, 7-9); a swing roller (60, bearings) movable along the guide sleeve and reciprocally movable together with the plunger (see columns

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3-4, lines 50-65 and 10-45, respectively); a pivot member (68) extending in a direction perpendicular to the guide sleeve, such that the guide sleeve is pivotal about the pivot member; and means for pivoting (70) the guide sleeve within a predetermined angle about the axis of the pivot member.

As to claim 3, the counterweight mass of Neitzell's device is substantially equal to that of the plunger.

As to claim 6, Neitzell's device discloses the use of a change shaft (with protrusions 80, see Figure 10) selectively engageable with the housing (66) for preventing and permitting the guide sleeve from its pivoting motion (see column 4, lines 43-60).

As to claim 7, Neitzell's device includes a moving mode changing means (70) changing a moving mode of the guide sleeve between a first moving mode for pivotally moving the guide sleeve about an axis for the pivot member within a predetermined pivot angle and a second moving mode for preventing the guide sleeve from being pivotally moved about the pivot member (see column 4, lines 43-67, column 5, lines 1-60).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 2, 8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neitzell.

Neitzell discloses the invention substantially as claimed including pivoting the guide sleeve between various angles; however, Neitzell does not specifically point out the pivot angle range of the guide sleeve being between 0.44 degrees to 1.54 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the guide sleeve pivot between 0.44 degrees to 1.54 degrees for the purpose of providing the desired amount of angle of attack to facilitate cutting, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7 of U.S. Patent No. 6,634,107.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the claim terminology used but encompass the same subject, i.e., claims 5-7 anticipate claim 9 of the instant application. Claims 5-7 and 9 claim the same subject matter with the only significant different in the language directed to the swing roller and the interaction of the swing roller and the tracks. Claims 5-7 disclose that the swing roller is either in a position not contact with the tracks or in contact with one of the two tracks. Therefore, claims 5-7 disclose first and second tracks and a swing roller such that the swing roller provides the first, second and third modes as claimed.

11. Claims 1 and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7 of U.S. Patent No. U.S. Patent 6,634,107 in view of Neitzell.

As to claim 1 of the instant application, claims 5-7 of '107 discloses the invention substantially as claimed except for the specific swing roller, pivot member and means for pivoting the guide sleeve; however, Neitzell discloses that it is old and well known in the saber saw art to use pivoting sleeves in combination with swing rollers, pivot members and means for pivoting the guide sleeve for the purpose of changes the angle of attack of the saw blade depending upon the type cut desired. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to claim with claims 5-7 of '107 a pivoting guide sleeve by way of swing rollers, pivot members, and means for pivoting in order to provide the desired angle of attack.

As to claim 7, of the instant application, claims 5-7 of '107 discloses the invention substantially as claimed except for the specific swing roller, pivot member and moving mode changing mean for pivoting the guide sleeve; however, Neitzell discloses that it is old and well known in the saber saw art to use pivoting guide sleeves in combination with swing rollers, pivot members and mode changing means for pivoting the guide sleeve for the purpose of changes the angle of attack of the saw blade depending upon the type cut desired. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to claim with claims 5-7 of '107 a pivoting guide sleeve by way of swing rollers, pivot members, and mode changing means for pivoting in order to provide the desired angle of attack.

#### ***Allowable Subject Matter***

12. Claim 9 appears to be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action, and to include a terminal disclaimer.

13. Claims 4-5, 10-11 and 13-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims and including a terminal disclaimer where necessary.

#### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

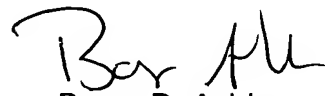


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Boyer D. Ashley  
Primary Examiner  
Art Unit 3724

BDA  
August 4, 2004